

## **REMARKS**

### **I. Claim Rejections Under 35 U.S.C. §102**

#### ***Prima Facie Anticipation Under 35 U.S.C. § 102***

A general definition of *prima facie* unpatentability under 35 U.S.C. § 102 is provided at 37 C.F.R. §1.56(b)(2)(ii):

A *prima facie* case of unpatentability is established when the information *compels a conclusion* that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability. (*emphasis added*)

"Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983) (citing *Soundsciber Corp. v. United States*, 360 F.2d 954, 960, 148 USPQ 298, 301 (Ct. Cl.), *adopted*, 149 USPQ 640 (Ct. Cl. 1966)), *cert. denied*, 469 U.S. 851 (1984). Thus, to anticipate the applicants' claims, the reference(s) cited by the Examiner must disclose each element recited therein. "There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991).

To overcome the anticipation rejection, the applicants need only demonstrate that not all elements of a *prima facie* case of anticipation have been met, *i. e.*, show that the reference cited by the Examiner fails to disclose every element in each of

the applicants' claims. "If the examination at the initial state does not produce a prima face case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992).

***Price-Francis***

Claims 1-21 and 23-43 were rejected under 35 U.S.C. 102(b) as being anticipated by Price-Francis (U.S. Patent No. 5,815,252). Applicant has amended claims 1 and 23 to account for these points of novelty.

Claim 1 as amended provides the following language:

A method for biometrically securing access to an electronic system, said method comprising the steps of: using a computer network to obtain a user profile from a server; prompting a user to input to a biometric user interface associated with said electronic system at least one biometric attribute randomly selected from said user profile containing biometric attributes of said user; and permitting said user to perform a user-desired activity, if at least one biometric attribute input by said user to said biometric user interface associated with said electronic system matches said at least one biometric attribute randomly selected from said user profile.

The scope of the claim is defined by explicit use of a computer network to access a server that contains user profiles. The Examiner may note that dependent claims 2 and 3 pertaining to accessing the user profile from a server or biometric broker via an electronic system were also rejected and that those rejections might apply to the amended claim 1. The examiner relies on Price-Francis (column 4 lines 50-67) which teaches a profile stored on a card. The card is not an element of a

computer network. It is a data storage device. Furthermore, any security inherent in the card is completely different from the key exchanges and encryption algorithms used in secure computer networks. The examiner also relies on Price-Francis (column 7 lines 60 through column 8 line 10) which teaches biometric data stored on a "main computer system". However, Price-Francis does not disclose, teach or suggest any means by which the biometric data can be accessed. In particular, Price-Francis never mentions the internet, computer networks, or secure computer networks. Rather Price-Francis teaches that the biometric data for many people can be stored on a single device and that many people's identity can be verified by using the data on that single device. Claim 1 as amended claims the storage and access of a user profile that is stored on a server that can be accessed on a computer network.

Furthermore, regarding claim 1, the Examiner argued that Price-Francis discloses a method for biometrically securing access to an electronic system, wherein the method comprises the steps of: prompting a user to input to the electronic system at least one biometric attribute randomly selected from a user profile containing biometric attributes of the user (citing column 5, lines 47-58) of Price-Francis; and permitting the user to perform a user-desired activity, if at least one biometric attribute input by the user to the electronic system matches the at least one biometric attribute randomly selected from the user profile (citing column 6, lines 40-58 of Price-Francis).

The Applicant reminds the examiner that in order to succeed in a rejection to a claim under 35 U.S.C. 102(b), the reference cited as a basis for rejecting the claim at issue must disclose each and every element of the rejected claim. If, as indicated above with respect to the requirements for prima facie anticipation under

35 U.S.C. 102, even one element or feature of the rejected claim is not disclosed in the cited reference, the rejection fails and must be withdrawn.

Thus, the Examiner argued that column 5, lines 47-58 of Price-Francis discloses the step of prompting a user to input to the electronic system at least one biometric attribute randomly selected from a user profile containing biometric attributes of the user, which is taught by Applicant's claim 1. Column 5, lines 47-58 of Price-Francis indicates the following:

Referring to the flow chart in FIG. 2, to initiate 62 the process 45, the owner 23 inserts a card 25 into a card reader/writer 45. Preferably, either by a display 42 or some other means, the card owner is also requested 64 to place one of his or her fingers on the fingerprint scanner 35. In this instance, the particular hand and associated finger requested for scanning is random, as the result of any conventional random algorithm. The fingerprint scanner 35 can be any of a wide range of suitable scanners, such as those manufactured by Digital Biometrics, Inc. The scanner 35 comprises a fingerpress having a transparent section through which the fingerprint image can be obtained.

Applicant notes that column 5, lines 47-58 of Price-Francis does not disclose, teach or suggest "at least one biometric attribute randomly selected from a user profile containing biometric attributes of the user". In fact, the above language from column 5, lines 47-58 does not suggest or mention the use of a user profile containing biometric attributes of the user. Column 5, lines 47-58 of Price-Francis does not describe a random selection taken from a user profile containing biometric attributes associated with the user, but instead only indicates that the particular hand associated finger requested for scanning is random, not a random biometric attribute selected from a user profile containing biometric attributes of the user. Instead, only the particular hand and associated finger of column 5, lines 47-58 requested for scanning is random, not the selection of the biometric attribute from a user profile associated with the user. The random algorithm of Price-Francis is

therefore not the same as the random selection process of Applicant's invention. The Examiner has not provided evidence to the contrary.

The Examiner additionally argued that column 6, lines 40-58 of Price-Francis discloses the step of permitting the user to perform a user-desired activity, if at least one biometric attribute input by the user to the electronic system matches the at least one biometric attribute randomly selected from the user profile (citing column 6, lines 40-58 of Price-Francis). Again, the Applicant respectfully disagrees with this assessment. Column 6, lines 40-58 of Price Francis indicates the following:

If a predetermined correlation exists between the recorded fingerprint characteristic data and the scanned fingerprint extracted characteristics at 92, a display associated with the PU 37 can either indicate the identification confirmation as by 101 of FIG. 4, or alternatively, a decision signal can be sent at 125 from the PU 37 to an operational device (not shown) such as a door or gate for security situations, coded lights can flash or the result can be displayed on one or more screens. The decisional pass/fail signal at 125 may also be transmitted back to the card reader/writer 45 to retain the card at 78 in a failure to identify situation or optically or otherwise mark the card at 78 to indicate border crossings, access to secured areas or other encoded records on the card at 78. A remotely located display (not shown) may also indicate that a match has been found, and thereby confirm identification. Instead of indicating confirmation on a display, of course, the verification decision can also be indicated through illumination of a specified color of light or other expedient, such as the opening of a door or gate.

Applicant notes that nowhere in column 6, lines 40-58 of Price-Francis is any mention made of a "user profile containing biometric attributes of the user". Additionally, no mention is made of permitting the user to perform a user-desired activity, if at least one (i.e. one or more) biometric attribute input by the user to the electronic system matches one or more of the biometric attributes randomly selected from the user profile.

Based on the foregoing, the Applicant submits that Price-Francis fails to disclose every element of Applicant's claim 1 as amended. Thus, the Applicant submits that the rejection to claim 1 has been traversed. Therefore, the Applicant respectfully requests withdrawal of the rejection to claim 1.

Claim 23 as amended provides the following language:

A system for biometrically securing access to an electronic system, said system comprising: a server connected to a computer network, adapted to store at least one user profile, and capable of allowing at least one biometric user interface associated with said electronic system also connected to said computer network to access said at least one user profile; a biometric user interface associated with said electronic system and connected to said computer network that accesses a user profile stored on said server that contains biometric attributes of said user and that prompts said user to input to said electronic system at least one biometric attribute randomly selected from said user profile; and an electronic system for permitting said user to perform a user-desired activity, if at least one biometric attribute input by said user to said biometric user interface matches said at least one biometric attribute randomly selected from said user profile.

Claim 23 as amended now includes a server accessible via a computer network wherein the server contains user profiles. The Applicant respectfully notes that the arguments presented above against the rejection to claim 1 apply equally and similarly to the rejection to claim 23. Thus, neither column 5, lines 47-58 nor column 6, lines 40-58 of Price-Francis teach, disclose or suggest a user profile containing biometric attributes associated with the user, nor does such language teach, suggest or disclose random selection of one or more biometric attributes from a user profile containing biometric attributes of the user. Additionally, no

mention is made in column 4, lines 50-67 nor column 7, line 60 through column 8 line 10 of Price-Francis of a server, computer network, or secure computer network.

Based on the foregoing, the Applicant submits that Price-Francis fails to disclose every element of Applicant's claim 23 as amended. Thus, the Applicant submits that the rejection to claim 23 has been traversed. Therefore, the Applicant respectfully requests withdrawal of the rejection to claim 23.

Claims 2-12, 14-21, 25-34 and 36-43 were rejected in part as dependent on claims 1 and 23. Traversing the rejections of claims 1 and 23 leads to traversing the rejections of claims 2-12, 14-21, 25-34 and 36-43. Therefore, the Applicant respectfully requests withdrawal of the rejection to claims 2-12, 14-21, 25-34 and 36-43.

### **III. Claim Rejections Under 35 U.S.C. §103**

#### ***Requirements for Prima Facie Obviousness***

The obligation of the Examiner to go forward and produce reasoning and evidence in support of obviousness under 35 U.S.C. §103 is clearly defined at M.P.E.P. §2142:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

M.P.E.P. §2143 sets out the three basic criteria that a patent examiner must satisfy to establish a *prima facie* case of obviousness necessary for establishing a rejection to a claim under 35 U.S.C. §103:

1. some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
2. a reasonable expectation of success; and
3. the teaching or suggestion of all the claim limitations by the prior art reference (or references when combined).

It follows that in the absence of such a *prima facie* showing of obviousness under 35 U.S.C. §103 by the examiner (assuming there are no objections or other grounds for rejection), an Applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443 (Fed. Cir. 1992).

Thus, in order to support an obviousness rejection under 35 U.S.C. §103, the Examiner is obliged to produce evidence compelling a conclusion that each of the three aforementioned basic criteria has been met.

***Price-Francis in view of Murakami et al***

Claims 22 and 44 were rejected by Examiner under 35 U.S.C. §103(a) as being unpatentable over Price-Francis in view of Murakami et al (U.S. Patent No. 6,483,929). Both claims have been amended to clarify that each further comprises a server accessible over a computer network wherein the server stores user profiles and makes the user profiles available to devices connected to the computer network. As discussed above, the amendments traverse rejections based on anticipation. As such, the third prong of *prima facie* obviousness is clearly not met nor should there be an expectation that the first prong is met.

Furthermore, regarding claim 22, the Examiner argued that Price-Francis discloses a method for biometrically securing access to an electronic system, said



method comprising the steps of prompting a user to input to said electronic system at least two biometric attributes randomly selected from a user profile containing biometric attributes of said user (column 5 lines 27-59, column 6 line 31 – column 7 line 12).

The Examiner admitted that Price-Francis does not explicitly mention permitting a user to perform a user-desired activity if the biometric attributes input by the user matches at least two biometric attributes randomly selected from the user profile. The Examiner argued, however, that Murakami discloses a method that uses more than one biometric attribute for authentication (column 4 lines 23-33, column 11 lines 24-40).

The Examiner asserted Murakami discloses that the use of multiple biometric attributes decreases the odds that an unauthorized individual will replicate the authorized person's biometric profile with the addition of each additional biometric attribute (column 4 lines 23-33). Price Francis has a system which has a plurality of biometric attributes stored and can successively repeat biometric data from a user based on a determination step (Figure 2). The Examiner argued that it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to modify the determining step of Price-Francis to require more than one positive affirmation of biometric identity to increase security when desired as in the method used by Murakami. The Examiner argued that the requirement of more than one positive biometric affirmation adds another measure of security while reducing the electronic sophistication of the equipment (Murakami column 2 lines 23-36) and to reduce the likelihood that an unauthorized person will improperly be granted access (Murakami column 2 lines 37-47).

In order to support an obviousness rejection, the Examiner is obliged to produce evidence compelling a conclusion that each of the three aforementioned

basic criteria has been met. The applicants respectfully assert that the rejection of Claim 22 herein fails under the third prong of the obviousness test because, for the reasons discussed *infra*, neither Price-Francis nor Murakami teaches nor suggests all of the limitations set out in the amended Claim 22.

Regarding claim 44, the Examiner argued that Price-Francis discloses a system for biometrically security access to an electronic system, said system comprising: a module for prompting a user to input to said electronic system at least two biometric attributes randomly selected from a user profile containing biometric attributes of said user (column 5 lines 27-59, column 6 line 31 – column 7 line 12). The Examiner admitted that Price-Francis does not explicitly mention permitting a user to perform a user-desired activity if the biometric attributes input by the user matches at least two biometric attributes randomly selected from the user profile. The Examiner argued, however, that Murakami discloses a method that uses more than one biometric attribute for authentication (column 4 lines 23-33, column 11 lines 24-40).

The Examiner asserted Murakami discloses that the use of multiple biometric attributes decreases the odds that an unauthorized individual will replicate the authorized person's biometric profile with the addition of each additional biometric attribute (column 4 lines 23-33). The Examiner argued that Price-Francis describes a system which has a plurality of biometric attributes stored and can successively repeat biometric data from a user based on a determination step (Figure 2). The Examiner therefore argued that it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to modify the determining step of Price-Francis to require more than one positive affirmation of biometric identity to increase security when desired as in the method used by Murakami. The Examiner asserted that the requirement of more than one positive biometric affirmation adds another measure of security while reducing the electronic

sophistication of the equipment (Murakami column 2 lines 23-36) and to reduce the likelihood that an unauthorized person will improperly be granted access (Murakami column 2 lines 37 - 47).

In order to support an obviousness rejection, the Examiner is obliged to produce evidence compelling a conclusion that each of the three aforementioned basic criteria has been met. The applicants respectfully assert that the rejection of Claim 44 herein fails under the third prong of the obviousness test because, for the reasons discussed *infra*, neither Price-Francis nor Murakami teaches nor suggests all of the limitations set out in the amended Claim 44.

#### **IV. Conclusion**

In view of the foregoing discussion, the Applicants have responded to each and every rejection of the Official Action. The Applicants have clarified the structural distinctions of the present invention by amendments herein. The foregoing discussion and amendments do not present new issues for consideration and no new search is necessitated. Such amendments are supported by the specification and do not constitute new matter. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. §103, and further examination of the present application.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned representative to conduct an interview in an effort to expedite prosecution in connection with the present application.

Respectfully submitted,

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A handwritten signature in cursive script, reading "Kermit Lopez", is written over a horizontal line.

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